b.) Remarks

Claims 11, 12 and 33-35 have been amended in order to recite the present invention with the specificity required by statute. Additionally, claims 36-38 are added in order to more specifically recite preferred embodiments of the present invention. No new matter has been added.

I. Objections to the Claims

Regarding an initial procedural matter, the claims were objected to as containing nonelected subject matter. However, as confirmed during telephone discussion with the Examiner on October 15, 2008, Applicants previously elected Group V (stated to be claim 16 at page 2 of the March 16, 2007 Office Action) and identified for search the species of compound 147. Moreover, the claims have all been amended to recite the searched subject matter as recounted by the Examiner in the June 29, 2007 Office Action.

Accordingly, during that telephone conference, the Examiner kindly indicated the scope of the claims -- including claim 11 pending herein -- is appropriate and in conformity with the Examiner's search and elected Group V.

The Examiner's assistance and cooperation in expediting prosecution with the undersigned in this regard is very gratefully acknowledged.

II. Rejection Under 35 U.S.C. §112

Claims 11, 12, 15-17 and 32-35 are rejected under 35 U.S.C. §112, first and second paragraphs, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the present invention and for failing to comply with the written description requirement. Accordingly, in order to reduce the issues, Applicants have above

amended claims 11, 12 and 33-35 to recite the substituents taught at specification pages 15-17. Therefore, this rejection is now overcome.

III. Rejection under 35 U.S.C. §103

Lastly, claim 11 is rejected under 35 U.S.C. §103(a) as being obvious over Sala (*Journal of the Chemical Society, Perkin Transactions 1: Organic and Bio-Organic Chemistry*, Vol. 3 (1981) 855-69) in view of Muller (Abstract of *Appl Microbiol Biotechnol*., Vol. 1-2 (2001) 9-16) and Silverman (*The Org. Chem. of Drug Design and Drug Action* (1992) 4-51).

The basis for this rejection is set forth at page 4 of the Office Action where the Examiner states the present invention is an ethyl homologue of Sala's methyl-substituted benzophenone compound 42 taught at page 857. This rejection is respectfully traversed.

As pointed out by the Examiner, Sala's compound is a synthetic intermediate in the synthesis of depsidones. In this regard, Sala states at page 855, lines 8-10

> it is proposed that depsidone biosynthesis involves the oxidative coupling of benzophenones to grisadienediones which then rearrange to depsidones.

The art does not mention whether Sala's compound (1) has any biological activity or (2) whether it actually exists as a precursor in the biosynthesis of depsidones. First, as to the latter point, if Sala was correct in his proposal, Applicants wish to point out there is no reason why an ethyl homologue would be useful and so there is no reason to

produce Applicants' compounds. Second, as to the former point, Muller teaches at page 1, lines 1-4

> "Lichen metabolites exert a wide variety of biological actions including antibiotics, antimycobacterial, antiviral, antiinflammatory, analgesic, antipyretic, antiproliferative and cytotoxic effects"

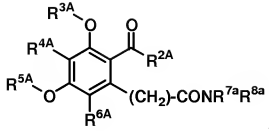
Although Muller describes a plethora of aliphatic acids, pulvinic acid derivatives, depsides, depsidones, dibenzofuans, anthraquinones, naphthoquinones and epidithiopiperazinediones on page 1, lines 10-13, Muller does not mention any benzophenone compounds (such as Sala's compound) as lichen metabolites.

That is to say, in other words, none of the prior art teaches that Sala's compound has any biological activity or is useful as a pharmaceutical. The Silverman reference does not remedy this.

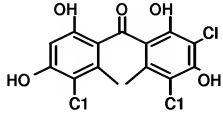
As relied upon by the Examiner, Silverman simply teaches optimizing drugs through chemical modification. However, a person having an ordinary skill in the art would not try to modify Sala's compound to obtain a novel compound ("with similar or improved properties") because Sala's compound was unknown to be biologically active in the first place.

Accordingly, Applicants respectfully submit claim 11 further recites patentable and unobvious subject matter.

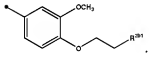
Moreover, in any event, Applicants' dependent claims further recite subject matter that is separately patentable in their own right. For instance, claims 32-35 recite the compound



In contrast, as acknowledged by the Examiner, Sala's most relevant structure is compound 42 which is



Plainly, the subject matter of claims 32-35 wherein R^{1a} is $CONR^{7a}R^{8a}$ is simply unobvious over the prior art, as well.

Similarly, claims 33 and 34 specify that R^{2A} is  and  , respectively. Additionally, claim 35 further specifies that R^{2a} is  . This subject matter too is not suggested by the prior art, whether taken singly or in combination.

IV. Petition to Withdraw Terminal Disclaimer

Regarding a final formal matter, with their May 6, 2008 Amendment Applicants filed a Terminal Disclaimer over the term of any patent issuing from application No. 10/584,234. However, in the '234 application there is never a carbonyl group next to R^{2A} as in the pending claim and so, the Terminal Disclaimer is now unnecessary. Accordingly, Applicants hereby Petition the Assistant Commissioner to withdraw the May 6, 2008 Terminal Disclaimer. Any fees for such Petition may be charged to Deposit Account No. 06-1205.

In view of the above amendments and remarks, Applicants submit that all of the Examiner's concerns are now overcome and the claims are now in allowable condition. Accordingly, reconsideration and allowance of this application is earnestly solicited.

Claims 11, 12, 15-17 and 32-38 remain presented for continued prosecution.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Lawrence S. Perry/
Lawrence S. Perry
Attorney for Applicants
Registration No. 31,865

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200
LSP\ac

FCHS_WS 2439711_1.DOC